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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILFRIED JUD,
RUDOLF JANACEK, and
JOACHIM PIETZSCH

Appeal 2007-3683
Application 10/083,110
Technology Center 1700

Decided: March 28, 2008

Before PETER F. KRATZ, CATHERINE Q. TIMM, and
JEFFREY T. SMITH, *Administrative Patent Judges*.
SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Statement of the Case

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 30-48. We have jurisdiction under 35 U.S.C. § 6.

Appellants invented a sterilizable composite film containing a barrier layer comprising a metal foil that is impermeable to water vapor and gases.

The film comprises on both sides of the barrier layer at least one functional layer. Claim 30 is reproduced below:

30. A sterilizable composite film containing a barrier layer that is impermeable to water vapor and gases comprising a metal foil and on both sides of the barrier layer at least one functional layer, the composite film having a layer structure containing one on top of the other:

(a) a first functional layer containing a first plastic film that is a polyester or polyolefin or an extrusion layer of a polyolefin or one or more lacquer layers, or print and lacquer layers, or print layers;

(b) a metal foil, the first plastic film is (i) in direct contact with the metal foil or (ii) in direct contact with a layer of a bonding agent that is in direct contact with the metal foil or (iii) in direct contact with a layer of a laminate adhesive that is in direct contact with the metal foil; and

(c) a second functional layer consisting of a second plastic film selected from the group consisting of (i) a plastic consisting of coextruded polyamide layer/polypropylene layer where the polyamide layer is in direct contact with the polypropylene layer, and (ii) a plastic consisting of coextruded polyamide layer/polypropylene layer with at least one suitable or conventional plastic system additive in either or both of the polyamide layer and the polypropylene layer and where the polyamide layer is in direct contact with the polypropylene layer, the polyamide layer lies between the meal [sic., metal] foil and the polypropylene layer, the polyamide layer is (1) in direct contact with the metal foil or (2) in direct contact with a layer of a bonding agent that is in direct contact with the metal foil or (3) in direct contact with a layer of a laminate adhesive that is in direct contact with the metal foil, the coextruded polyamide layer/polypropylene has a bond of sufficient to prevent delamination thereof during sterilization.

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The prior art set forth below is relied upon by the Examiner as evidence of unpatentability.

Ohtsuki	4,407,689	Oct. 4, 1983
Breitler	5,589,275	Dec. 31, 1996
Migliorini	5,591,520	Jan. 7, 1997
Abrams	6,090,471	Jul. 18, 2000

The Examiner entered the following rejections.

- I. Claims 30, 34, and 38 stand rejected under 35 U.S.C. § 102(b) over Migliorini.
- II. Claims 30, 34, and 38-45 stand rejected under 35 U.S.C. § 102(b) over Breitler.
- III. Claims 39-45 stand rejected under 35 U.S.C. § 103(a) over Migliorini in view of Breitler.
- IV. Claims 30-38 and 43-47 stand rejected under 35 U.S.C. § 103(a) over Ohtsuki.
- V. Claims 39-42 stands rejected under 35 U.S.C. § 103(a) over Ohtsuki in view of Breitler.
- VI. Claim 48 stands rejected under 35 U.S.C. § 103(a) over Ohtsuki in view of Abrams.

- I. Claims 30, 34, and 38 stand rejected under 35 U.S.C. § 102(b) over Migliorini.¹

¹ Appellants have presented arguments for all the claims together. Consequently, all the claims will stand or fall with the arguments presented for independent claim 30.

The Examiner contends Migliorini describes a high barrier metallized film with excellent bond strengths comprising a coextruded multilayer film. The Examiner contends “that the polyamide/polypropylene film taught by Migliorini would inherently meet the instant limitation with regards to delamination during sterilization given that the film is formed by **coextrusion** as instantly claimed and wherein the aluminum layer taught by Migliorini [et al] reads upon the term ‘aluminum foil’ considering the recited claims do not limit the term ‘foil’ to any particular aluminum layer thickness.” (Answer 3-4).

Appellants contend that none of the generic or specific statements in Migliorini anticipate or suggest the claimed invention. In support of this contention, Appellants identify specific portions of the Migliorini reference followed by the statement “[t]here is no anticipation by this quotation from Migliorini et al. because, for example, this quotation does not disclose appellants’ claimed coextrudate.” (*See* for example Br. 8, 9 and 11). Appellants contend that Migliorini does not disclose a coextrudate consisting of a polyamide layer and a polypropylene layer. Rather, every coextrudate in Migliorini is different. (Br. 12).

The issue before us is whether Appellants have shown that the Examiner erred in rejecting claims 30, 34 and 38 under 35 U.S.C. § 102(b). We answer this question in the affirmative. Therefore, WE REVERSE.

We agree with Appellants that Migliorini does not disclose a composite film including the claimed layer structure. As a first matter, to obtain a film meeting the requirements of claim 30, one of ordinary skill in

the art would have to pick and choose and combine various disclosures within Migliorini not directly related to each other. Such picking and choosing is improper in a § 102 rejection. *See In re Arkley*, 455 F.2d 586, 587-88 (CCPA 1972) (“Such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the similarity of the subject matter which he claims to the prior art, but it has no place in the making of a 102, anticipation rejection.”). We also agree with Appellants that Migliorini does not disclose the plastic of the second functional layer (c) that consists of coextrudate of a polyamide layer and a polypropylene layer. (Br. 6). Migliorini’s example is closest structurally to the claimed composite film, but the film of the example contains a three layer coextruded functional layer. The C-layer of ethylene-propylene butane-1 terpolymer of that coextruded functional layer is excluded by the “consisting of” language in part (c) of claim 30. The Migliorini reference disclosure is insufficient to establish anticipation of the claimed subject matter.

II. Claims 30, 34, and 38-45 stand rejected under 35 U.S.C. § 102(b) over Breitler.²

The Examiner contends Breitler describes composite films suitable for sterilization containers that comprise plastic layers on both sides of a metal

² Appellants have presented arguments for all the claims together. Consequently, all the claims will stand or fall with the arguments presented for independent claim 30.

layer. The composite films may include composites of two or more films or layers wherein the polyamide-based thermoplastic layers may additionally and independent of each other be provided with an outer lying sealable layer and/or barrier layer of thermoplastics, such as a polypropylene sealable layer. Breitler discloses the sealable layers are sealable films joined together by adhesives or lamination. Breitler discloses a number of layer arrangements wherein the plastic films may be formed by warm coating or coextrusion and may be subjected to stretch-drawing, to produce a composite film. (Answer 4-5).

Appellants contend that Breitler does not teach or suggest the claimed composite. Appellants contend that Breitler discloses a polyamide layer on each side of the metal foil. However, Breitler does not disclose any member of the first functional layer between either of its polyamide layers and its metal layer; therefore Breitler does not teach the claimed composite film. (Br. 15-26).

The issue before us is whether Appellants have shown that the Examiner erred in rejecting claims 30, 34, and 38-45 under 35 U.S.C. § 102(b). We answer this question in the affirmative. Therefore, WE REVERSE.

We agree with Appellants that Breitler does not disclose a specific embodiment that anticipates the claimed invention. That is, a coextrudate consisting of a polyamide layer and a polypropylene layer. Rather, Breitler describes a composite comprising a variety of layer arrangements suitable for the formation of sterilization containers that comprise plastic layers on

both sides of a metal layer. This disclosure is insufficient to establish anticipation.

III. Claims 39-45 stand rejected under 35 U.S.C. § 103(a) over Migliorini in view of Breitler.

The burden of establishing a *prima facie* case of unpatentability rests upon the Examiner. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); citing *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (“As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.”). The subject matter of claim 39 is dependent upon independent claim 30. In order to determine whether the subject matter of claim 39 is properly rejected under § 103 the Examiner must first provide a determination as to whether the subject matter of claim 30 would have been patentable under § 103. As to claim 30, the Examiner has failed to provide an obviousness analysis for Migliorini or Breitler. Consequently, the Examiner has not made accurate and sufficient factual findings such that it is reasonable to conclude that one of ordinary skill in the art would have been motivated to form a sterilizable composite film comprising the claimed structural arrangement within the meaning of 35 U.S.C. § 103.

Therefore WE REVERSE.³

³ Appellants in the discussion of the § 102 rejections over Migliorini and Breitler have presented arguments directed to suggestions provided by the references.

IV. Claims 30-38 and 43-47 stand rejected under 35 U.S.C. § 103(a) over Ohtsuki⁴

Based on the contentions of the Examiner and the Appellants, the issue before us are:

(1) Has the Examiner made accurate and sufficient factual findings such that it is reasonable to conclude that one of ordinary skill in the art would have been motivated to form a sterilizable composite film comprising the claimed structural arrangement within the meaning of 35 U.S.C. § 103? (2) Has Appellants presented evidence sufficient to overcome the rejection under § 103?

We answer the first question in the affirmative and the second question in the negative. Therefore, we AFFIRM.

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). “[A]nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007) quoting *In re Kahn*, 441 F.3d 977, 988

⁴ Appellants have presented arguments for all the claims together. Consequently, all the claims will stand or fall with the arguments presented for independent claim 30.

(Fed. Cir. 2006); *see also DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006) (“The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself.”); *In re Bozek*, 416 F.2d 1385, 1390 (CCPA 1969) (“Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness ‘from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.’”); *In re Hoeschele*, 406 F.2d 1403, 1406-07 (CCPA 1969) (“[I]t is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom . . .”).

We have thoroughly reviewed each of Appellants’ arguments. However, we are in full agreement with the Examiner that the claimed subject matter is unpatentable over the cited prior art. Accordingly, we will sustain the Examiner’s rejection.

The Examiner contends Ohtsuki describes composite films suitable for sterilization containers that comprise plastic layers on both sides of a metal layer. The Examiner contends that Ohtsuki discloses the composite films are joined together by coextruding. Ohtsuki recognizes the suitability of utilizing polyamide and polypropylene to form the extrudeable plastic layers. (Col. 3, ll. 20-32). Ohtsuki discloses the film layers can be formed from different materials. (Col. 3, ll. 40-42). Thus, a person of ordinary skill

in the art would have reasonably expected that the sterilizable composite films could have been formulated comprising a coextruded polyamide layer and polypropylene layer. (Answer 7-8).

Appellants contend that the claimed invention addresses a specific problem and solves that specific problem. Ohtsuki does not recognize such problem and does not teach or suggest a solution to such problem. (Br. 35-39). Appellants also contend that Ohtsuki does not provide motivation to use a coextrudate consisting of a polyamide layer and a polypropylene layer. (Br. 39).

Ohtsuki discloses composite films wherein the layers could have been joined together by coextruding. Ohtsuki recognizes the suitability of utilizing polyamide and polypropylene to form the extrudeable plastic layers. Thus a person of ordinary skill in the art would have reasonably expected that the sterilizable composite films could have been formulated comprising a coextruded polyamide layer and polypropylene layer. The delamination characteristic identified in the claim appears to be a consequence of the layers having been coextruded. Appellant has not identified specific extrusion techniques that result in a patentable distinction from the techniques known in the art and shown by the reference. A person of ordinary skill in the art following the teachings of Ohtsuki would have been motivated to form composite films comprising a coextruded polyamide layer and polypropylene layer even if for a different reason than that intended by Appellants. For a prima facie case of obviousness to be established, however, the reference need not recognize the problem solved

by the Appellants. *See In re Kemps*, 97 F.3d 1427, 1430 (Fed. Cir. 1996); *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992); *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Int. 1985) (“The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.”)

Appellants also contend that they have “found an unexpected invention, with an unexpected result, that is unfathomable from the forest of the Ohtsuki et al. disclosure.” (Br. 38). Appellants, however, fail to point to any evidence indicating that the results obtained were considered to be unexpected to one of ordinary skill in the art. “It is well settled that unexpected results must be established by factual evidence. Mere argument or conclusory statements in the specification does not suffice.” *In re Soni*, 54 F.3d 746, 750 (Fed.Cir.1995) (*quoting In re De Blauwe*, 736 F.2d 699, 705 (Fed.Cir.1984)). The question here, we emphasize, is a question of evidence and the burden is on the Appellants to show unexpected results. *In re Johnson*, 747 F.2d 1456, 1460 (Fed. Cir. 1984).

V. Claims 39-42 stands rejected under 35 U.S.C. § 103(a) over Ohtsuki in view of Breitler.

Appellants contend there is no motivation of record for one ordinarily skilled in the art to use a coextrudate of polyamide and polypropylene. There is no suggestion in Ohtsuki et al. that such a coextrudate will cure the problem (that Ohtsuki et al. does not mention) of delamination of separate

layers, or even a coextrudate, of any of two thermoplastics, let alone polyamide and polypropylene

The Examiner relied upon the Breitler reference for describing the characteristics of the aluminum foil. Appellants have not adequately rebutted the Examiner's determination regarding the properties of the foil disclosed by Breitler and the suitability of utilizing this foil in the film of Ohtsuki. Appellants' arguments are principally the same as those presented in response to the rejection over Ohtsuki alone. Thus, we affirm the rejection of claim 39 for the reasons set forth above and by the Examiner in the present record.⁵

VI. Claim 48 stands rejected under 35 U.S.C. § 103(a) over Ohtsuki in view of Abrams.

Appellants' arguments regarding claim 48 are not persuasive. Claim 48 specifies that the first functional layer (a), is a polyester, a printed image is printed on the outside of the polyester layer and a lacquer coating covers the image. The Examiner relies on Abrams for describing these limitations of claim 48. Appellants have not adequately rebutted the Examiner's determination regarding the structure described by Abrams and the suitability of utilizing this arrangement in the film of Ohtsuki. Appellants contend that Abrams does not cure the defects of Ohtsuki (Br. 42). Thus, we affirm the rejection of claim 48 for the reasons set forth above and by the Examiner in the present record.

⁵ Appellants have not presented separate arguments for rejected claims 39-42. Thus, we select claim 39 as representative of the rejected claims.

DECISION

The rejections of claims 30-48 under 35 U.S.C. § 103(a) over Ohtsuki alone and in combination with other references are affirmed. The rejections of claims 30, 34, and 38 under 35 U.S.C. § 102(b) over Migliorini; claims 30, 34, and 38-45 under 35 U.S.C. § 102(b) over Breitler; and claims 39-45 under 35 U.S.C. § 103(a) over Migliorini in view of Breitler; are reversed.

ORDER

The rejection of claims 30, 34, and 38 under 35 U.S.C. § 102(b) over Migliorini is reversed.

The rejection of claims 30, 34, and 38-45 under 35 U.S.C. § 102(b) over Breitler is reversed.

The rejection of claims 39-45 under 35 U.S.C. § 103(a) over Migliorini in view of Breitler is reversed.

The rejection of claims 30-38 and 43-47 under 35 U.S.C. § 103(a) over Ohtsuki is affirmed.

The rejection of claims 39-42 under 35 U.S.C. § 103(a) over Ohtsuki in view of Breitler is affirmed.

The rejection of claims 48 under 35 U.S.C. § 103(a) over Ohtsuki in view of Abrams is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

tf/ljs

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